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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,962	08/24/2001	Laurence Victor Marks	RAL920000102US1	2139

25299 7590 07/27/2004

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,962

Applicant(s)

MARKS, LAURENCE VICTOR

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

Figures 1-6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Paragraph 39 should be changed from "...control transfers to **906**..." to "...control transfers to **910**..." to match Fig. 9.

Fig. 7 step 922 reads "remove item[n] from order. Redisplay order page with remaining items. Paragraphs 34 and 42 describe what happens when a user clicks on "Remove from shopping cart." Paragraph 42 should be changed *from*

...This will look similar to the screen he was viewing, except that one line of address and credit card data will have been deleted...

to

...This will look similar to the screen he was viewing, except that one line of the order [shopping cart] will have been removed...

Appropriate correction is required.

Claim Objections

The following claims are objected to because of informalities:

Claims 1-6, 10, 11-12 and 17-18 refer to various types of "...screens..." that are not described in the specifications, although the Abstract mentions a "...multi level order entry screen..." For example, Claims 1, 3, 4, 6, 10, 12, 16 and 18 refer to a "...control screen..." that appears to correspond to applicant's Fig. 7. Claims 2, 3, 5, 6, 11, 12, 17 and 18 refer to a "...parameter entry input screen..." that appears to correspond to prior art in Figs. 3 and 4. The descriptive labels impart little patentable moment in distinguishing the instant claims from prior art. For purposes of applying prior art, the various types of "...screens..." will be given their broadest reasonable interpretation to read on a first screen and a second screen.

Claims 1, 3, 4, 6, 10, 12, 16 and 18 refer to various "...entry means..." that are not described in the specifications. For example, Claims 1 and 16 refer to a "...user controlled data entry means..." Claims 4 and 10 refer to a "...user controlled order entry means..." Claims 4, 6, 10 and 12 refer to a "...order entry means..." Claims 1, 3, 16 and 18 refer to a "...data entry means..." The descriptive material imparts little patentable moment in distinguishing the instant claims from prior art. For purposes of applying prior art, the various "...entry means..." will be given their broadest reasonable interpretation to read on a client on a network.

Claims 7 and 13 read, in part, "...said at lest one profile field..." This should read "...said at *least* one profile field..."

Claim 10 reads, in part, "...means response to a request from a user at an order entry means for accessing..." This should read, "...means, *in* response to a request from a user at an order entry means for accessing..."

Claims 1, 4, 8-10 and 14-16 refer to "parameters unique" to a user and "unique parameters" in the profile field. The specification does not provide a standard for ascertaining a requisite degree of uniqueness. For purposes of this examination, the terms will be given their broadest reasonable interpretation to include a record that contains information concerning a user.

Claims 1, 4, 10 and 16 refer to "...data for defining a [first] screen..." The first screen (Fig. 7), when displayed, contains **(a)** information from a user profile field that has a plurality of parameters, such as billing, shipping information, as in prior art Figs.3-4 **(b)** button fields for adding, deleting and updating the plurality of parameters found in a selected user profile, **(c)** fields for displaying shopping cart information and **(d)** a button field for removing an item from a shopping cart. Items **(b)**, **(c)** and **(d)** **are not** part of a user profile or a user profile field in applicant's invention. However, claims 7-9 and 13-15 appear to claim otherwise:

...said at least one profile field includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action. (claims 7 and 13)

...user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field. (claims 8, 14)

...unique parameters in the profile field include a credit card number sub-field, a ship to address sub-field and a bill to address sub-field. (claims 9, 15)

Consistent with the disclosures, the Examiner will interpret user profile and user profile field as synonyms that **exclude** (claims 7, 13) "...user selectable sub-fields each

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of which when selected by the user defines a unique action..." (claims 8, 14) "user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 4-6, 10-12 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat (US 6,459,499).

As per claims 1, 4, 10 and 16, Tomat discloses apparatus and methods for

Storing data in memory. See for example, at least Col. 4, lines 47-58 and related Fig. 2. The data may be used for defining a first screen that includes multiple fields. See, for example, at least Fig. 10 and related text. The fields include parameter fields that contain data unique to a user, such as a user's name. The screen also includes additional fields, including a "Add/Edit" field for indicating, when selected by a user, the need to create an additional profile containing different parameters unique to the requesting user.

Generating and transmitting a first screen to a client via the communications system. See, for example, at least Fig. 10, which has been generated, transmitted and

displayed on a client under the control of the user. For communications system and network, please refer at least to Fig. 3 and related text.

As per claims 2, 5, 11 and 17 Tomat discloses apparatus and methods whereby, in response to a request from a user for an additional profile, generates and transmits a second screen where a user may enter and input parameter data concerning an additional profile. See, for example, Fig. 6 and related text. The screen is generated, transmitted and displayed on a client over a communications network.

As per claims 3, 6, 12 and 18 Tomat discloses apparatus and methods, in response to the receipt of a completed second screen from a user, for updating stored data defining the first screen and generating, transmitting and displaying the updated first screen that includes the stored data. See, for example, at least Fig. 10 and related text, which shows that Mr. Tanaka has two profiles.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat (US 6,459,499) in view of Spiegel et al (US Patent 6,620,079).

As per claims 7 and 13, Tomat **does not** specifically disclose that the profile includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action. Spiegel discloses a profile that includes a plurality of user-selectable fields, including "Check Out" "Finalize Now." See, for example, at least Fig. 2 and related text. These fields define unique actions such as checking out and finalizing.

As per claims 8 and 14, Tomat **does not** specifically disclose that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field. Spiegel discloses selectable fields for requesting an order entry (Fig. 1, button 103b, Fig. 2, fields 201(a) and 201(b). For edit, see Fig. 2, see field 303.

As per claims 9 and 15 Tomat **does not** specifically disclose that the unique parameters include credit card number sub-field, a ship to address sub-field and a bill to address sub-field. Spiegel discloses fields for shipping and billing information. See, for example, Fig. 2, item 203 and related text. For credit card, please see at least Col. 2, lines 35-59.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to combine Tomat and Spiegel to disclose that (claim 7) a profile includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action, (claim 8) that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field

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requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field and (claim 9) that the unique parameters include credit card number sub-field, a ship to address sub-field and a bill to address sub-field.

One of ordinary skill in the art the time the invention was made to would have been motivated combine Tomat and Spiegel to disclose that (claim 7) a profile includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action, (claim 8) that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field and (claim 9) that the unique parameters include credit card number sub-field, a ship to address sub-field and a bill to address sub-field for the obvious reason that by doing so, a user may conduct business in different roles and a user may select a profile that already has the appropriate billing and shipping information. This makes it possible for a user to purchase certain types of videos using billing and shipping information that is different from billing and shipping information he would use for ordering in work-related products, as suggested by Spiegel in Col. 9, line 29-Col. 10, line 30.

Conclusion

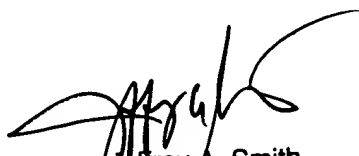
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
27 July 2004


Jeffrey A. Smith
Primary Examiner